

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No.: 76/018,582

For the Mark: EMAX ACROPRISE & Design

Applicant: Acroprise Inc.

Filed on: April 5, 2000



04-29-2002

U.S. Patent & TMO/TM Mail Rpt Dt.

02 MAR - 3 PM 9:23
TRADEMARK TRIAL AND
APPEAL BOARD

RE/MAX INTERNATIONAL, INC.,

Opposer,

v.

ACROPRISE INC.,

Applicant.

Opposition No.: _____

"EXPRESS MAIL" MAILING LABEL NUMBER: EL922585842US

I hereby certify that this paper or fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" Service under 37 CFR § 1.10 on the date indicated above and is addressed to: BOX TTAB - FEE, ASSISTANT COMMISSIONER FOR TRADEMARKS, 2900 Crystal Drive, Arlington, VA 22202-3513 on APRIL 29, 2002.

LEBOEUF, LAMB, GREENE & MACRAE, LLP

By:

Sharon S. Holdorf

BOX TTAB - FEE

Assistant Commissioner for Trademarks

2900 Crystal Drive

Arlington, VA 22202-3513

NOTICE OF OPPOSITION

RE/MAX International, Inc., a Colorado corporation, located and doing business at 8390 East Crescent Parkway, Suite 600, Greenwood Village, Colorado 80111 (hereinafter "Opposer") believes that it will be damaged by the registration of EMAX ACROPRISE & Design, a mark sought to be registered through U. S. Trademark Application Serial No. 76/018,582, filed on April 5, 2000, by Acroprise, Inc., corporation incorporated under the laws of the People's Republic of China, located at 9F-3, NO. 2, LANE 150, HSIN YI RD., SEC. 5, TAIPEI, TAIWAN, People's Republic of China (hereinafter "Applicant"), and Opposer hereby opposes same.

The grounds for opposition are as follows:

1. Opposer is a major, well-established company that provides real estate brokerage services throughout the United States through a network of franchisees, sub-franchisors and affiliated sales agents who are authorized by Opposer to use Opposer's registered trademarks in connection with real estate brokerage services.

2. Opposer, since at least as early as 1974, has provided real estate brokerage services in interstate commerce through brokerage offices owned and operated by it and, since at least as early as 1977, through its sub-franchisors, franchisees, and affiliated sales agents, all in connection with its distinctive registered trademarks, "REMAX" and "RE/MAX" (collectively, the "RE/MAX marks"). Opposer is the owner of Federal Trademark Registration Numbers 1,139,014; 1,339,510; and 2,403,626 for its service mark "RE/MAX," and the owner of Federal Trademark Registration Numbers 2,106,387 and 2,054,698 for its service mark "REMAX." Copies of these registrations are attached as Exhibit A.

3. The RE/MAX marks are used on a variety of advertising media including yard signs, business cards, newspapers and other print media, directional signs, open house signs, hot and cold air balloons, television commercials, billboards, bus stop benches, transit buses, moving vans, banners, brochures, coffee mugs and other advertising and promotional items.

4. Since at least as early as 1974, Opposer and Opposer's Affiliates have invested over two billion dollars to develop, promote and maintain the RE/MAX marks in the United States and worldwide. More specifically, Opposer's Affiliates have used the RE/MAX marks in connection with over nine million home sale transactions in the United States and worldwide, resulting in over one trillion dollars in sales volume from as early as 1974 to present date.

5. As a result of substantial sales and extensive advertising and promotion, the RE/MAX marks have become widely and favorably known as identifying real estate brokerage services originating from, sponsored by or associated with Opposer. Indeed, the RE/MAX marks

are famous. The public has to associate the RE/MAX marks with Opposer as a source of high quality real estate brokerage services.

6. Applicant filed U.S. Trademark Application Serial No. 76/018,582 on April 5, 2000, seeking to register EMAX ACROPRISE & Design as a trademark in connection with "Blank computer discs; blank floppy computer discs; blank hard computer discs; compact discs featuring enterprise resource planning, supply chain management, electronic commerce, business information management concerning marketing and demographic data, customer relationship management, finance, logistics, and the manufacturing of computers and computer peripherals circuit boards, automobiles and machines; computers; computer game programs; computer operating programs; computer software to automate data warehousing; computer software and computer programs for use in enterprise resource planning, supply chain management, business information management concerning marketing and demographic data, and customer relationship management; computer software and computer programs for use in database management, for use as a spread sheet, for calculating, searching and word processing in the field of electronic commerce, finance, logistics, and the manufacturing of computers and computer peripherals, circuit boards, automobiles and machines; computer software for use in enterprise resource planning, supply chain management, business information management concerning marketing and demographic data, and customer relationship management that may be downloaded from a global computer network; computer software for use in database management, for use as a spread sheet, for calculating, searching and word processing in the field of electronic commerce, finance, logistics, and the manufacturing of computers and computer peripherals, circuit boards, automobiles and machines that may be downloaded from a global computer network; optical discs," in International Class 9; "Promoting the goods and services of others by preparing and placing advertisements in an electronic magazine accessed through a global computer network," in International Class 35; and "Broadcasting programs via a global computer network; network conferencing services; providing multiple-user access to a global computer information network;

providing telecommunications connections to a global computer network," in International Class 38; and "Rental of computers and software," in International Class 42. Applicant's application was filed under an intent-to-use basis.

7. Applicant's mark, EMAX ACROPRISE & Design, when used in connection with the services identified in Application Serial No. 76/018,582 is likely to cause confusion, or to cause mistake, or to deceive consumers as to an affiliation, connection or association between Opposer and Applicant, or as to the origin, sponsorship, or approval of Applicant's goods, services or other commercial activities.

8. Opposer's RE/MAX name and marks are of sufficient fame and reputation among consumers that, when Applicant's EMAX ACROPRISE & Design mark is used in connection with the services set forth in Applicant's Application, a false connection with Opposer will be presumed by consumers.

9. Applicant's EMAX ACROPRISE & Design mark, when used in connection with the services identified in Application Serial No. 76/018,582, is likely to dilute the distinctive quality of Opposer's famous RE/MAX marks.

10. Applicant's use of EMAX ACROPRISE & Design for the services set forth in Application Serial No. 76/018,582 is not authorized by Opposer.

11. The registration of Applicant's EMAX ACROPRISE & Design mark on the Principal Register would be inconsistent with Opposer's rights under the aforementioned registrations, the common law and the Trademark Act, and would be damaging to Opposer.

WHEREFORE, Opposer RE/MAX INTERNATIONAL, INC. prays that this opposition be sustained, that U.S. Trademark Application Serial No. 76/018,582 for EMAX ACROPRISE & Design be rejected, and that registration by Applicant be refused and denied.

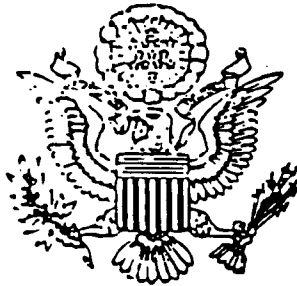
A duplicate copy of this Notice of Opposition and the fee required in 37 C.F.R. § 2.6(a)(17) are enclosed herewith.

Respectfully submitted this 29th day of April, 2002.

LEBOEUF, LAMB, GREENE & MACRAE, LLP

By: Nancy L. Dempsey
George G. Matava
John R. Posthumus
Nancy L. Dempsey
633 17th Street, Suite 2000
Denver, Colorado 80202
(303) 291-2600

ATTORNEYS FOR OPPOSER



Nº 1139014

THE UNITED STATES OF AMERICA

CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof.

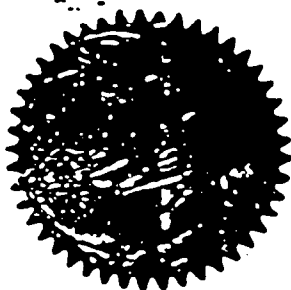
And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for Twenty Years unless sooner terminated as provided by law.



In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this twenty-sixth day of August, 1980.

William D. Diamond

COMMISSIONER OF PATENTS AND TRADEMARKS

Int. Cls.: 35 and 36

Prior U.S. Cl.: 101

United States Patent and Trademark Office

Reg. No. 1,139,014

Registered Aug. 26, 1980

SERVICE MARK

Principal Register

RE/MAX

Re/Max of America, Inc. (Colorado corporation)
5555 S. Limon Way
Englewood, Colorado 80110

FOR RENDERING TECHNICAL AID AND ASSIST-
ANCE TO OTHERS IN THE ESTABLISHMENT AND
OPERATION OF A REAL ESTATE BROKERAGE
AND REAL ESTATE BROKERAGE SERVICES, in
CLASS 35 (U.S. Cl. 101)
First use Jan. 30, 1973, in commerce Jan. 1, 1973.
FOR REAL ESTATE BROKERAGE SERVICES, in
CLASS 36 (U.S. Cl. 101)
First use Jan. 30, 1973, in commerce Jan. 1, 1973.

See No. 1,139,014 Filed Jan. 21, 1977.

MARC BERGSMAN, Primary Examiner



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trade Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

REGISTRATION NO. 1139014

SERIAL NO. 73/113283

PAPER NO.

MAILING DATE: 10/27/86

MARK: RE/MAX

REGISTRANT: RE/MAX INTERNATIONAL, INC.

CORRESPONDENCE ADDRESS:

BERGSON, BORKLAND, MARGOLIS & ADLER
11 DUPONT CIRCLE, NORTHWEST
WASHINGTON, D.C. 20036

Please furnish the following
in all correspondence:

1. Your phone number and zip code.
2. Mailing date of this action.
3. Affidavit-Renewal Examiner's name.
4. The address of all correspondence
not containing fees should include
the words "Box 5".
5. Registration No.

RECEIPT IS ACKNOWLEDGED OF THE SUBMITTED REQUEST UNDER:

SECTION 8 OF THE TRADEMARK STATUTE AND 37 CFR SECS. 2.161-2.166.

SECTION 15 OF THE TRADEMARK STATUTE AND 37 CFR SECS. 2.167-2.168.

YOUR REQUEST FULFILLS THE STATUTORY REQUIREMENTS AND HAS BEEN ACCEPTED.

A. J. GORE
AFFIDAVIT-RENEWAL EXAMINER
TRADEMARK EXAMINING OPERATION
(703) 557-1989



Nº 1339510

THE UNITED STATES OF AMERICA

CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

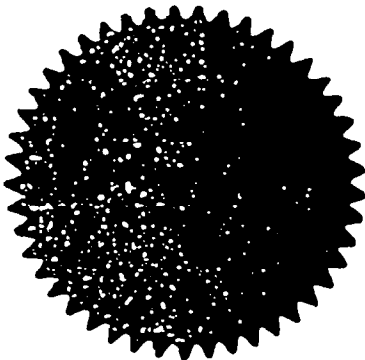
And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for Twenty Years unless sooner terminated as provided by law.



In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this fourth day of June, 1985.

Acting Commissioner of Patents and Trademarks

NOTICE

This Registration will be canceled by the Commissioner of Patents and Trademarks at the end of six years following the date of registration, unless within one year next preceding the expiration of such six years, the registrant files in the Patent and Trademark Office an affidavit showing that said mark is in use in Commerce or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. A fee of \$100.00 for each class must accompany the affidavit.

Int. Cl.: 36

Prior U.S. Cl.: 102

United States Patent and Trademark Office

Reg. No. 1,339,510

Registered June 4, 1985

**SERVICE MARK
PRINCIPAL REGISTER**

RE/MAX

RE/MAX OF AMERICA, INC. (COLORADO
CORPORATION)
5251 S. QUEBEC
ENGLEWOOD, CO 80111

FOR: INSURANCE BROKERAGE SERVICES.
IN CLASS 36 (U.S. CL. 102).

FIRST USE 4-1-1980; IN COMMERCE
4-1-1980.

OWNER OF U.S. REG. NO. 1,139,014.

SER. NO. 510,503, FILED 11-26-1984.

SHARON R. MARSH, EXAMINING ATTORNEY

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,403,626

United States Patent and Trademark Office

Registered Nov. 14, 2000

**SERVICE MARK
PRINCIPAL REGISTER**

RE/MAX

**RE/MAX INTERNATIONAL, INC. (COLORADO CORPORATION)
8390 EAST CRESCENT PARKWAY, SUITE 600
GREENWOOD VILLAGE, CO 80111**

FOR: PROVIDING A WEBSITE ON GLOBAL COMPUTER NETWORKS FEATURING INFORMATION IN THE FIELD OF REAL ESTATE, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 8-1-1995; IN COMMERCE 8-1-1995.

OWNER OF U.S. REG. NOS. 1,139,014, 2,119,607 AND OTHERS.

SER. NO. 75-712,611, FILED 5-24-1999.

CAROLINE WEIMER, EXAMINING ATTORNEY

The United States of America



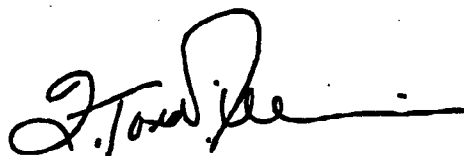
CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office; that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Director of the United States Patent and Trademark Office; and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



Director of the United States Patent and Trademark Office

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,106,387

United States Patent and Trademark Office

Registered Oct. 21, 1997

**SERVICE MARK
PRINCIPAL REGISTER**

REMAX

REMAX INTERNATIONAL, INC. (CORPORATE)
CORPORATION
5425 110 PARKWAY, SUITE 1200
ENGLEWOOD, COLORADO

FIRST USE 1-1-1977, IN COMMERCE
1-1-1977

OWNER OF US REG NO 1,339,510.

SER NO 75-068,799, FILED 3-7-1996.

FOR REAL ESTATE BROKERAGE SERV.
ICES IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

RUSS HERMAN, EXAMINING ATTORNEY

The United States of America



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Bence Lehman

Commissioner of Patents and Trademarks

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,054,698

United States Patent and Trademark Office

Registered Apr. 22, 1997

**SERVICE MARK
PRINCIPAL REGISTER**

REMAX

RE/MAX INTERNATIONAL, INC. (COLORADO
CORPORATION)
5445 DTC PARKWAY, SUITE 1200
ENGLEWOOD, CO 80111

FOR: FRANCHISE SERVICES, NAMELY, OF-
FERING TECHNICAL ASSISTANCE IN THE
ESTABLISHMENT AND/OR OPERATION OF
REAL ESTATE BROKERAGE FIRMS, IN
CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 1-1-1977; IN COMMERCE
1-1-1977.

OWNER OF U.S. REG. NOS. 1,139,014 AND
1,173,586.

SER. NO. 75-068,927, FILED 3-7-1996.

RUSS HERMAN, EXAMINING ATTORNEY

The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office, that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks, and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

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Bence Lehman

Commissioner of Patents and Trademarks